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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/060,712	01/29/2002	Bartley K. Andre	APL1P234C1/P2426USC1	8995
22434	7590	04/28/2004	EXAMINER	
BEYER WEAVER & THOMAS LLP P.O. BOX 778 BERKELEY, CA 94704-0778			LESPERANCE, JEAN E	
		ART UNIT		PAPER NUMBER
		2674		19
DATE MAILED: 04/28/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/060,712	ANDRE ET AL.
	Examiner Jean E Lesperance	Art Unit 2674

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 26 January 2004.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 10, 12-15, 18, 20-22, 25-28, and 30-42 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 20-22, 25-28, 30-34, 36, 37, 39 and 42 is/are allowed.

6) Claim(s) 10, 12-15, 18, 35, 38, 40, and 41 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 29 January 2002 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### ***Drawings***

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed. Applicant is reminded of the proper content of an abstract of the disclosure.

### ***Claim Objections***

Claim 30 is objected to because of the following informalities: it depends on a cancelled claim. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10, 12-15, 18, 35, 38, 40, and 41 are rejected under 35 U.S.C. 102 (b) as being unpatentable over U.S. Patent number 5,585,823 ("Duchon et al.").

As for claim 10, Duchon et al. teach a one-button computer mouse includes a housing movable over a reference surface (abstract, lines 1 and 2) corresponding to a mouse capable of executing a button function, the computer mouse 18 includes a single button 40 coupled to the housing 36 (column 4, lines 28 and 29) corresponding to the button function being incorporated into a housing component of the mouse, micro-

switch 68 and 70 form a switch mechanism 71 (column 5, lines 13 and 14) corresponding to the housing component being configured to substantially enclose electronics associated with the mouse. And it is inherent in the art to the housing of a mouse to include electronic components.

As for claim 12, Duchon et al. teach the button Fig.2 (40) is pressed and held down by the user, to put the cursor in a "drag" mode which can drag windows and other objects around the computer screen (column 2, lines 18-21) corresponding to the button function is associated with performing an on screen action.

As for claims 13 and 14 Duchon et al. teach computer systems having graphical user interfaces (GUI) are typically provided with some form of pointing device which controls a cursor on the computer screen (column 1, lines 10-12) corresponding to the electronics generate on screen action signals and generate cursor control signals and the internal components include electronics associated with moving a cursor on a display.

As for claim 15, Duchon et al. teach the button is pressed and held down by the user to put the cursor in a "drag" mode which can drag windows and other objects around the computer screen (column 2, lines 18-21) corresponding to a mouse housing configured to be grasped and manipulated by a hand of a user, micro-switch 68 and 70 form a switch mechanism 71 (column 5, lines 13 and 14) corresponding to the mouse housing encasing mouse electronics, and the force increases to force F1 which moves button portion 58 to a position X1, at which time the first switch 70 is activated (column

5, lines 57-59) corresponding to serving as a movable button so as to perform an on screen action.

As for claim 18, Duchon et al. teach the single button is movable between a base position, a first button position and a second button position by a force exerted on the button (abstract, lines 5-7) corresponding to the mouse housing includes a first member and a second member where the base position corresponding to the first member and the first and second positions corresponding to the second member, the computer mouse 18 includes a single button 40 coupled to the housing 36 and movable between a base position, a first button position and a second button position by a force referred generically to as "F" exerted on the button 40 (column 4, lines 28-32) corresponding to the first and second members cooperating to form a housing of the mouse, the button is biased to the base position in absence of a force (abstract, lines 8 and 9) corresponding to the first member being configured to make moving contact with a surface, the first switch is used as a normal mouse button switch to indicate to "click" of the mouse button. The second switch then is used to indicate that the mouse is in a locked button state. However, the use of the additional mouse data is purely under software control, such that the SWITCH2 data could, for example, be programmed to emulate a double-click of SWITCH1, or for other user-definable purposes (column 6, lines 38-45) corresponding to the second member being movably coupled to the first member so as to provide a clicking action associated with performing the on screen action.

As for claim 38, Duchon et al. teach a mouse 18 with a single button 40 which contains no separate mechanical buttons where the entire button has to be pressed down to execute the button function Fig.2 (40) corresponding to the top member is an integrated piece having no separate mechanical buttons disposed thereon.

As for claim 35, Duchon et al. teach a one-button computer mouse includes a housing movable over a reference surface (abstract, lines 1 and 2) corresponding to a the button function being incorporated into a housing component of the mouse, the computer mouse 18 includes a single button 40 coupled to the housing 36 (column 4, lines 28 and 29) corresponding to the button function being incorporated into a housing component of the mouse, a mouse 18 with a single button 40 which contains no separate mechanical buttons where the entire button has to be pressed down to execute the button function Fig.2 (40) corresponding to the housing component is pushed in its entirety to execute the button function.

As for claim 40, Duchon et al. teach a mouse 18 with button 40 integrates into housing top to form the entire top of the mouse (Figure 2).

As for claim 41, Duchon et al. teach a mouse 18 with button 40 integrates into housing top to form the entire top of the mouse (Figure 2) with no mechanical buttons for data selection and command execution disposed on and flush with the mouse surface.

### ***Allowable Subject Matter***

Claims 21-22, 25-28, 30-34, 36, 37, 39, and 42 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: the claimed invention is directed to an input device. Independent claim 20 identifies a uniquely distinct feature "an integral top member cooperating with the base member to form a housing of the input device that encases internal components of the input device, the integral top member moving relative to the base member to provide a clicking action, the integral top member being movably coupled to the base member, the integral top member being capable of moving between a first position, placing the integral top member away from the base member and a second position, placing the integral top member towards the base member". Independent claims 32 and 36 identify a uniquely distinct feature "a top member mechanically coupled with the base member to form the mouse housing and to encase said mouse electronics, the top member defining the entire top surface of the mouse housing, the top member moving relative to the bottom member between a first position, placing the top member away from the base bottom member and a second position, placing the top member towards the base bottom member, so as to implement a clicking action, the entire top member serving as a movable button for implementing the clicking action". Independent claim 42 identifies a uniquely distinct feature "an integral top member mechanically coupled to the base member to encase the electronics, the integral top member and the base member being coupled and engaged in a manner that allows the integral top member to serve as a button for activating an internal electronic switch to register palm clicking as an input to the electronics".

***Response to Amendment***

Applicant's arguments filed 1-26-2004 have been fully considered but they are not persuasive. The applicant argued that the prior art does not teach the button function being incorporated into a housing component of the mouse, the housing component being configured to substantially enclose electronics associated with the mouse. Examiner disagrees with the applicant's statement because the prior art teaches the only button 40 integrating with housing top 36 to form the top surface is incorporated in a housing component of mouse 18. Button 40 is also part of the housing because it is incorporated with 36 to form the entire top surface. The applicant argued that the prior art does not teach a housing 36 that is movable so as to perform an onscreen option. Examiner disagrees with the applicant because the housing 36 is incorporated with button 40 to form entire top surface is movable so as to perform a clicking operation. The applicant argued that the prior art does not teach a mouse configured to be grasped and manipulated by a hand of a user. Examiner disagrees with the applicant because the prior art teaches a mouse 18 that is capable of being manipulated by the user's hand by holding it with the palm hand and fingers. Therefore, the rejection is maintained.

**Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean Lesperance whose telephone number is (703) 308-6413. The examiner can normally be reached on from Monday to Friday between 8:00AM and 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Hjerpe, can be reached on (703) 305-4709 .

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 872-9314 (for Technology Center 2600 only)

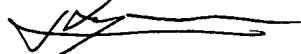
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal

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drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Jean Lesperance



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Date 4-21-2004



RICHARD HJERPE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600